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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| EXAMINER | |
|---|---|
| HANNE, SARA M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2179 | |

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/086,761 | LAHTI ET AL. | |
| | Examiner | Art Unit | |
| | Sara M Hanne | 2179 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/28/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-38 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-48 of copending Application No. 10/086757. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all share the same concept of invention and similar claim limitations. This is a provisional obviousness-type double patenting rejection since the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 9-18, 21-29, 32-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Biffar, US Patent 6397212.

As in Claims 1, 13, 24, 36 and 38, Biffar teaches a system, method and software for automatically generating a graphical user interface (GUI) element at a client system according to a current configuration model, comprising a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow (Figure 2), when generated the first frame comprising data reflecting the current configuration model (4300 Information Fig. 3), when generated the first frame further comprising a function operable when executed at the client system in response to a call to automatically access the data stored in the first frame reflecting the current configuration model ("Fig. 7A is the starting selection ... and shows a preset display of the currently most popular car model in its most popular configuration", Column 11, lines 23-25) according to the accessed data, determine a configuration choice for which an appropriate GUI element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow (Column 6, lines 15-24) and make a callback requesting that an appropriate GUI element for the configuration choice be drawn, and a second frame associated with the web page and generated at the server system for communication to the client system in association with the first frame (4100 Description), when generated the second frame comprising one or more parameters specifying the GUI element (Fig 7a-n, and corresponding text) that will be appropriate for the configuration choice depending on the current configuration model as reflected in the data stored in the first

frame (user-configured characteristics), when generated the second frame further comprising code operable when executed at the client system to automatically call the function of the first frame to determine a configuration choice for which an appropriate GUI element needs to be displayed to the user associated with the client system in connection with the configuration workflow, receive a callback from the function of the first frame requesting that an appropriate GUI element for the configuration choice be drawn, and according to the one or more parameters stored in the second frame, draw the GUI element that is appropriate for the configuration choice (Fig. 7a-n, 4600).

As in Claim 2, 14 and 25, Biffar teaches the GUI element appropriate for the configuration choice is generated on the fly at the client system (Column 5, line 58 et seq.).

As in Claim 3, 15 and 26, Biffar teaches the first frame is operable to reflect a change to the configuration model independent of manual modification of the first frame subsequent to the change, the first frame when generated in connection with a configuration workflow initiated before the change comprising data reflecting the configuration model before the change, the first frame when generated in connection with a configuration workflow initiated after the change comprising data reflecting the configuration model after the change (Column 11, line 3 et seq.).

As in Claim 4, 12, 16, 25 and 27, Biffar teaches the first and second frames belong to a frameset (4000) associated with the web page and are communicated to the client system in response to the user initiating the configuration workflow ("The item

searched for can reside on different data bases, and/or Web sites.", Column 5, lines 49 et seq.).

As in Claim 5, 17 and 28, Biffar teaches the configuration model is a product configuration model, the configuration workflow is workflow to configure a product, and the configuration choice is associated with one or more available selections for configuring a corresponding portion of the product (Col. 4. line 34 et seq.).

As in Claim 6, 18 and 29, Biffar teaches wherein the GUI element for the configuration choice is associated with a dynamic Hypertext Markup Language (Col. 11, line 6 et seq.) layer and comprises a label (4100 Description).

As in Claims 9, 21 and 32, Biffar teaches the second frame is operable to cause a connector to be created for the GUI element for the configuration choice in response to generation of the GUI element, the connector providing an active link between the GUI element and a property of a configuration element associated with the configuration choice, the connector allowing the GUI element to be automatically re-drawn in response to user input during the configuration workflow affecting the property of the configuration element without requiring the second frame to be re-drawn in its entirety at the client system (Figure 7 and corresponding text).

As in Claims 10, 22 and 33, Biffar teaches the first frame comprises functions each operable when executed at the client system in response to a call to create a connector for a corresponding type of GUI element (changing functions in the first frame changes the type of GUI element displayed) and the second frame comprises code associated with the GUI element for the configuration choice, the code being generated

automatically at runtime at the client system in response to generation of the GUI element (when the web page is opened up) and operable to automatically call the function in the first frame corresponding to the type of the GUI element to create a connector for the GUI element (See Example in Col. 11-13).

As in Claims 11, 23 and 34, Biffar teaches a third frame associated with the web page and generated at the server system for communication to the client system in association with the first frame (Type) and second frame (Color), when executed at the client system the third frame (Description 4100) operable to receive from the second frame data representing a selection associated with the configuration choice post the data received from the second frame as a Hypertext Transfer Protocol (HTTP) request to the server system (normal webpage/server interaction), receive an HTTP response from the server system comprising data reflecting a current state of a configuration in relation to the configuration mode (Picture in Description), the current state reflecting the selection, and communicate the data received from the server system to the second frame to initiate updating of the GUI element for the configuration choice (Figure 7 and corresponding text).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 7, 19, 30 and 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Biffar, US Patent 6397212., and further in view of Ahluwalia, US Patent 6728685.

As in Claims 7, 19, 30 and 37, Biffar teaches a system, method and software for automatically generating a graphical user interface (GUI) element at a client system according to a current configuration model, comprising a first frame associated with a web page and generated at a server system for communication to a client system in connection with a configuration workflow, when generated the first frame comprising data reflecting the current configuration model, when generated the first frame further comprising a function operable when executed at the client system in response to a call to automatically access the data stored in the first frame reflecting the current configuration model according to the accessed data, determine a configuration choice for which an appropriate GUI element needs to be drawn for display to a user associated with the client system in connection with the configuration workflow and make a callback requesting that an appropriate GUI element for the configuration choice be drawn, and a second frame associated with the web page and generated at the server system for communication to the client system in association with the first frame, when generated the second frame comprising one or more parameters specifying the GUI element that will be appropriate for the configuration choice depending on the current configuration model as reflected in the data stored in the first frame when generated the second frame further comprising code operable when executed at the client system to automatically call the function of the first frame to determine a configuration choice for which an appropriate GUI element needs to be displayed to the

user associated with the client system in connection with the configuration workflow, receive a callback from the function of the first frame requesting that an appropriate GUI element for the configuration choice be drawn, and according to the one or more parameters stored in the second frame, draw the GUI element that is appropriate for the configuration choice (See Claim 1 rejection *supra*) and the GUI element appropriate for the configuration choice is generated on the fly at the client system (Claim 2 rejection *supra*). While Biffar teaches the aforementioned multiple frame interface with configuration choices determining GUI elements, they fail to show the wherein the first and second frames comprise Javaserver Pages (JSPs), the called function of the first frame comprises a Javascript function, and the calling code of the second frame comprises Javascript code as recited in the claims. In the same field of the invention, Ahluwalia teaches an update interface for product customization similar to that of Biffar. In addition, Ahluwalia further Javaserver Pages (JSPs), a called function comprising a Javascript function, and calling code comprising Javascript code (Column 7, lines 42-50 and Ref. 1801). It would have been obvious to one of ordinary skill in the art, having the teachings of Biffar and Ahluwalia before him at the time the invention was made, to modify the multiple frame interface with configuration choices determining GUI elements taught by Biffar to include the JavaScript of Ahluwalia, in order to obtain JavaScript capabilities for creating the connections. One would have been motivated to make such a combination because a independent web-customizable interface would have been obtained, as taught by Ahluwalia.

7. Claims 8, 20 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biffar, US Patent 6397212.

As in Claim 8, 20 and 31, Biffar discloses the first frame operating as an API and the second frame comprising a viewable configuration dialog frame associated with the web page (See Claim 1 rejection *supra*). Biffar fails to teach the first frame to be non-viewable as recited in the claims. Within the field of the invention, it would be obvious to one of ordinary skill in the art to make the first frame non-viewable. One would have been motivated to make such a combination because a way to view information without allowing the user to edit it would have been obtained.

***Conclusion***

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar e-commerce display interfaces with interactive frames.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

BA HUYNH
PRIMARY EXAMINER